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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

PETER AR-FU LAM

Serial No. 09/930,422

Filed: 12/22/2009

For: Body Profile Coding Method  
And Apparatus Useful For  
Assisting Users To Select  
Wearing Apparel

Hon. Commissioner of Patents  
and Trademarks

Examiner:  
Buchanan, Christopher R

Group: 3627

Docket: BPCODE 2

May 10, 2010

Sir,

Renewed Petition to Director – according to 37 CFR 1.181 (a) 1

The applicant wishes to express his most sincere thanks for the Director for providing the decision dated 03/11/2010. The applicant agrees all the opinion of the decision concerning Part B. For Part A, the applicant respectfully agrees with all the principles and opinion of law quoted by the decision. After repeatedly reviewing the decision and the previous office actions, with great effort trying to comply with the guideline of the decision and provide a proper response, the applicant was still facing difficulty to draft a proper response. After reconsidering the decision of the petition as a whole, it was found that there is still one claim limitation failed to be clarified by the office action according to the requirement of the patent rules, and as indicated by the decision:

(a) How each claim limitation is interpreted in the prior art if the prior art had in deed disclosed the claim limitation; or

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(b) If the prior art did not explicitly disclosed the claimed limitation, the reason how the difference is found obvious according to patent rules.

**Part (A): Adequate information about ground of rejection:**

**Statement of facts**

1. In various previous communications between the applicant and the examination office, the applicant had respectfully requested (the "First Request") the office action to "clearly" identify how the claimed limitations had been disclosed in the cited prior art Spackova, US Patent 4,539,585. The information is required for the applicant to compose a proper response for overcoming a rejection of independent claim 40 under 35 U.S.C. 103(a).
2. Listed below is a quotation of precedent court ruling *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) – herein abbreviated as the "Graham inquiry":

*Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:*

- (a) Determine the scope and content of the prior art; and*
- (b) Ascertaining the differences between the claimed invention and the prior art; and*
- (c) Resolving the level of ordinary skill in the pertinent art for the obvious combination or modification.*
- (d) Evaluate other objective evidence and secondary considerations relevant to the issue of obviousness*

Graham inquiry set forth the examination process required to determine if an invention is obvious as compared with a prior art. The ground to support applicant's First Request was firstly based on step (b) of the Graham inquiry.

3. Applicant's Request was then based on the quotation of 37 CFR 1.104(b) and MPEP 707.07:

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*Completeness and clarity of examiner's action.  
The examiner's action will be complete as to ALL matters.*

According to 37 CFR 1.104(b) and MPEP 707.07, it is the right of the applicant to demand clear explanation how **EVERY** claim limitation, one by one is interpreted, and how the corresponding claim interpretation is exactly found in the figure and element numbers of the drawings, or located in the wording description in column and line numbers of the prior art specification.

4. Applicant's First Request was further based on the following views of the patent rules:

**(a) MPEP 2111.01 I - Plain Meaning [R-5]**

**I.THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS \*\*>SUCH MEANING IS INCONSISTENT WITH< THE SPECIFICATION**

*In re American Academy of Science Tech Center, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)*

**(b) MPEP 2111.01 III - Plain Meaning**

**III.< "PLAIN MEANING" REFERS TO THE ORDINARY AND CUSTOMARY MEAN-ING GIVEN TO THE TERM BY THOSE OF ORDINARY SKILL IN THE ART**

*Phillips v. AWH Corp., \*>415 F.3d 1303, 1313<, 75 USPQ2d 1321>, 1326< (Fed. Cir. 2005) (en banc). Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)*

**(c) MPEP 2112.02 - Process Claims**

**PROCESS CLAIMS — PRIOR ART DEVICE ANTICIPATES A CLAIMED PROCESS IF THE DEVICE CARRIES OUT THE PROCESS DURING NORMAL OPERATION**

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The above quotations, although are not the subject matter of the subject petition, are in fact related to the guideline to determine if the previous office actions had properly and adequately complied with the requirements set forth by the Graham inquiry, **37 CFR 1.104(b)** and **MPEP 707.07** herein.

5. Listed below is the recitation of pending independent claim 40:

40. A method of processing a body profile (BP) code describing the physical dimensions of a human body to facilitate garment shopping, said method comprising the steps of:

- (1) specifying the positions of the body to be measured for defining m different physical dimensional parameters of said human body;
- (2) measuring in length unit each of said m defined parameters a physical dimension of said body to produce m values; and
- (3) processing said m values to produce a multiple digits compressed BP code for representing said m values.

6. The limitations recited by claim 40 are outlined as follow:

- (a) a step to define m different physical dimensional parameters of a human body (Note: in a preferred embodiment of the application, the physical dimensional parameters of a claimed BP Code are defined to be "Arm Length", "Neck Diameter", "Torso length", "Waist Diameter" and "Leg Length" respectively);
- (b) step (a) is defined by specifying the position of the body to be measured for each of the defined physical dimensional parameter (Note: the positions of the body to measure "Arm Length", . . . "Leg Length" respectively);
- (c) a process to measure each of said m defined parameters to produce a value expressed in "length unit".

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(d) a process to "process" said  $m$  values to produce a "multiple digits" "compressed" BP code for representing said  $m$  values.

7. After carefully applying the principles and guideline provided by the decision dated 03/11/2010, the applicant agrees with the findings of the decision in the following limitations:

**Limitation 6(b):**

The office action had indicated that the positions claimed are represented by the indicia segments (72) and coded indicia (74); although the applicant does not agree that these segments (72) and coded indicia (74) can be used to define the  $m$  different physical dimensional parameters, "**without departing from the original operation principle of prior art Spackova**"; the applicant agrees that this difference in opinion is an issue to be reviewed by appeal and not a petitionable issue.

**Limitation 6(c):**

The office action indicated the system of Spackova can be used to measure the claimed  $m$  physical dimensional parameters. Although the applicant does not agree that the normal operation of Spackova to serve it intended purpose, as required by MPEP 2112.02 is to provide measurements of  $m$  physical dimensional parameters in unit length, again this is an issued to be reviewed by appeal and not by the petition process.

**Limitation 6(d):**

This is the part related to Part B of the petition and is already solved by the decision. The help of the Director is sincerely appreciated.

**Limitation 6(a):**

This is the particularly identified limitation **NOT** yet resolved and need the help of the Director in this renewed petition. Upon repeatedly review the

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office action, and fully considered the guideline provided by the decision, the applicant is still unable to understand how the m different physical dimensional parameters are disclosed by Spackova. As further indicated by the decision, if the m different physical dimensional parameters are not disclosed by Spackova, the office action failed to provide the reasons why these m different physical dimensional parameters are "obvious" to be provided under the normal operation of Spackova.

8. The present situation is that the office action took the hint sight after reading the subject application that there existed (or alternatively obvious addition) m different physical dimensional parameters in prior art Spackova without identifying if these m different physical dimensional parameters "**existed**" or "**obvious**" to prior art Spackova. In order to comply with **37 CFR 1.104(b)**, **MPEP 707.07** and precedent Supreme Court ruling *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); the office action is first required to clarify it's position if the claimed m different physical dimensional parameters had been disclosed by prior art or not. This is important because the nature of response to drafted by the applicant will be different. If the office action considered the m different physical dimensional parameters had been disclosed by Spackova and clearly identified what are the m different physical dimensional parameters disclosed by the prior art, the strategy of the applicant may be amend the claim language of the parameters or to argue why the m different physical dimensional parameters are **NOT** properly interpreted according to the disclosure of Spackova as a whole. If the position of the position is that these m different physical dimensional parameters are not disclosed by Spackova but they are obvious to the prior art Spackova, then the strategy of the applicant is to argue why these m different physical dimensional parameters are not obvious according to the normal operation of Spackova.

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**Points to be reviewed**

1. Did the office action identified:
  - (a) The m different physical dimensional parameters recited in the subject claim 40 are disclosed by prior art Spackova; or
  - (b) The m different physical dimensional parameters are **NOT** disclosed by prior art Spackova, but they are obvious to Spackova under the normal operation of Spackova;
2. If the office action had indicated that m different physical dimensional parameters recited in the subject claim 40 are disclosed by prior art Spackova, where in the prior evidences are found to support this conclusion?
3. If the office action had indicated that these m different physical dimensional parameters recited in the subject claim 40 cannot be found in the prior art Spackova, then did the office action explain the reasons why these m different physical dimensional parameters are obvious to the disclosure of Spackova in order to comply with 37 CFR 1.104(b)?

**Action requested**

1. With this petition, the applicant respectfully requested the Director to review the language of the office action and help the applicant to understand the meaning of the office action if:
  - (a) The m different physical dimensional parameters are disclosed by prior art Spackova;

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- (b) The m different physical dimensional parameters are NOT disclosed by prior art Spackova, but they are obvious to Spackova under the normal operation of Spackova;
2. If the Director is in the same position of the applicant and unable to identify the above requested action point (1), the Director is respectfully requested to provide a decision requesting the examiner to clarify the above action point (1), in accordance to **37 CFR 1.104(b)**, **MPEP 707.07** and precedent Supreme Court ruling *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966).
  3. If the Director is able to find a way of interpretation that the previous office action had in deed indicated the m different physical dimensional parameters had been disclosed by prior art Spackova; then the Director is respectfully requested to help the applicant to identify how the office action interpreted the m different physical dimensional parameters to be disclosed by prior art Spackova. The applicant needs to know this answer granted under **37 CFR 1.104(b)**, in order to decide if he wants to amend further detail of the dimensional parameters, or elected to argue that the interpretation of the office action is improper.
  4. If the Director is able to find a way of interpretation that the previous office action had in deed indicated the m different physical dimensional parameters had **NOT** been disclosed by prior art Spackova; but these m parameters are obvious to the prior art Spackova under it's normal operation, then the Director is respectfully requested to help the applicant to locate where in the office action the reasons why the m physical dimensional parameters are obvious addition to the disclosure of Spackova? The applicant needs to know these reasons in order to decide if a claim amendment is proper or a strategy to argue about the obviousness evidences is a more proper response.



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**Part (B): Request of supporting prior art or an affidavit under 37 C.F.R. 1.107(b) about the level of skill to take an office notice stated in lieu of a supporting prior art.**

The Decision dated 03/11/2010 had properly addressed Part (B) of the previous petition dated 02/19/2010. The applicant sincerely thanks for the effort and work provided by the Director.

**Timely filing of the petition**

This petition is timely filed within two months from 03/11/2010, the mailing date of the latest decision.

**Nature of the petition**

The renewed petition is related to difference in opinions to provide clear ground of rejection, procedural matters of the subject patent application. The applicant needs the clarification requested herein to decide the different strategy of providing a proper response.

Respectfully submitted,



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